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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,988	12/28/1999	TERUAKI OKUDA	35.G2524	9448

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT PAPER NUMBER

1774

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/472,988

Applicant(s)

OKUDA, TERUAKI

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7-11 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 and 18-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claim 18 has been withdrawn from further consideration as being drawn to a non-elected invention. The restriction was made in Paper No. 14 and was made final in Paper No. 18. Claim 18 belongs in Group II directed to a print. Claims 19-22 belong in the elected Group I and will be examined.

2. In view of amendments to the claims which require the average particle size of the latex to be 0.1 to 1 micron, rejection over Sakaki et al. has been overcome.

3. Claims 1-3, 6 and 19-22 are rejected under 35 U.S.C. 103(a) as being obvious over Ichinose et al. (6,550,909) taken alone or in view of either of Malhotra (6,180,238) or Cousin et al. (4,554,181). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned

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by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Ichinose et al. disclose an ink jet recording material comprising a substrate, a porous layer including inorganic pigment, and a porous layer of polymer particles that form a film upon heating (see col. 5, lines 15-26). The resin particles are thermoplastic, include particles of polyvinyl chloride and copolymers thereof with other monomers. From this disclosure, it would have been obvious to one of ordinary skill in the art to utilize common commercially available thermoplastic resin copolymers such as vinyl chloride-vinyl acetate copolymer in the absence of unexpected results. The particles have an average diameter of 0.1 to 5.0 microns (see col. 7, lines 15-36). The support may be paper (see col. 9, lines 35-55). The inorganic pigment may be alumina hydrate (see col. 11, lines 12-37). The reference does not disclose coating on both surfaces however, it would have been obvious to do so in order to make both surfaces ink receptive so that both surfaces may be printed. It would have been obvious to one of ordinary skill in this art to make the coatings the same thicknesses or different thicknesses depending upon the type and amounts of ink intended to be printed on each surface so that desired printing results are achieved and the medium is not unnecessarily thick.

Malhotra and Cousin et al. each disclose sheets for ink jet recording comprising supports with ink receptive coating layers thereon. Each reference discloses that both front and back surfaces of the supports may be coated (see Malhotra, col. 39, lines 32-44 and Cousin et al., the examples). In light of these teachings that it is known in the art

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to apply ink receptive coatings to both surfaces of a support, it would have been obvious to one of ordinary skill in the art to apply the coatings of the primary reference to both surfaces in order to render both surfaces printable.

4. Claims 1-3, 6 and 19-22 are directed to an invention not patentably distinct from claims 1-10 of commonly assigned USPN 6,550,909. Specifically, the patent claims disclose an ink jet recording medium comprising a substrate and a porous layer of thermoplastic particles thereon. There may be a layer of inorganic pigment in between (cl. 6). While the claims of the patent do not recite the material of the thermoplastic particles or inorganic particles, these aspects of the invention are obvious from the claims of the patent as read in light of the specification (note the sections of the patent set forth above in the rejection under 35 USC 103). Further, coating both sides of the support at coatings weights that are standard in the art would have been obvious from the patent so that the medium may be recorded on both surfaces. It also would have been obvious to vary the coating weights of the layers to achieve desired printing results.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 6 and 19-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,550,909 taken alone or in view of Malhotra (6,180,238) or Cousin et al. (4,554,181). The patent claims disclose an ink jet recording medium comprising a substrate and a porous layer of thermoplastic particles thereon. There may be a layer of inorganic pigment in between (cl. 6). While the claims of the patent do not recite the material of the thermoplastic particles or inorganic particles, these aspects of the invention are obvious from the claims of the patent as read in light of the specification. Further, coating both sides of the support at coatings weights that are standard in the art would have been obvious from the patent so that the medium may be recorded on both surfaces. It would have been obvious to one of ordinary skill in this art to make the coatings the same thicknesses or different thicknesses depending upon the type and amounts of ink intended to be printed on each surface so that desired printing results are achieved and the medium is not unnecessarily thick.

Malhotra and Cousin et al. each disclose sheets for ink jet recording comprising supports with ink receptive coating layers thereon. Each reference discloses that both front and back surfaces of the supports may be coated (see Malhotra, col. 39, lines 32-44 and Cousin et al., the examples). In light of these teachings that it is known in the art to apply ink receptive coatings to both surfaces of a support, it would have been obvious

to one of ordinary skill in the art to apply the coatings of the primary reference to both surfaces in order to render both surfaces printable.

7. Applicant's arguments with respect to claims 1-3 and 6 have been considered but are moot in view of the new ground(s) of rejection. It is noted that applicants have made some broad statements with respect to the secondary references to Malhotra and Cousin et al. (see page 8 of applicants' response). The examiner was unable to locate the teaching in either of Malhotra or Cousin et al. that both surfaces were coated in order to reduce curl, nor did the examiner rely upon such teachings in formulating the rejections above. If applicants intend to argue that Malhotra and Cousin et al. only suggest coating both surfaces in order to reduce curl and are not successful in demonstrating that this technique reduces curl, then it is requested that applicants identify statements leading to the conclusion that coating of both surfaces was only for the purpose of reducing curl, as well as the examples that demonstrate that coating of both surfaces failed to reduce curl in each of the secondary references.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

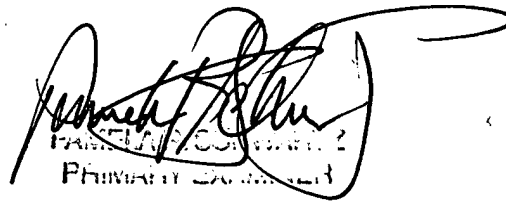
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz

January 5, 2005



PR Schwartz  
January 5, 2005